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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaiyara	45010005211	2222
7590 William S. Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
EXAMINER GIARDINO JR, MARK A				
ART UNIT		PAPER NUMBER		
2185				
MAIL DATE		DELIVERY MODE		
07/20/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,871

**Applicant(s)**

MUKAIHARA ET AL.

**Examiner**

MARK GIARDINO JR

**Art Unit**

2185

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*/Stephen Elmore/*

**DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/2011 has been entered.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

**REJECTIONS NOT BASED ON PRIOR ART**

**a. DEFICIENCIES IN THE SPECIFICATION**

***Specification***

The specification is objected to for the following informalities:

Paragraph 0002: "connected to PC or the like" has been construed as "connected a PC or the like".

Paragraph 0002: "editing and the like of an image file by using PC" has been construed as "editing and the like of an image file by using a PC".

Paragraph 0005: "Under the above-described circumstances" – what circumstances are meant is not clear.

**b. DEFICIENCIES IN THE CLAIMED SUBJECT MATTER**

**Claim Rejections - 35 USC ' 112**

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 recites "a storage element for storing data output from said host machine" in line 4 of the claim, indicating that the program data (such as the reproduction program data and execution program data) are output from the host (thus indicating these programs are already stored on the host) to the storage element of the portable memory device. However, other claim limitations (e.g., "when the host machine does not store the reproduction program data, the execution program data and the driver program data, the install program data automatically installs the reproduction program data, the execution program data and the driver program data on the host machine in response to connecting the portable memory device to the host machine" on lines 17-21 of claim 9) indicate that the reproduction program data and execution

program data are not stored on the host, which contradicts the previous limitation of "a storage element for storing data output from said host machine". If any of these claim limitations are optional, this must be more clearly and consistently expressed in the claim to resolve this contradiction. As claimed currently, one of ordinary skill in the art would not know how to make and/or use the invention, as how the host machine outputs the writing program data and reproduction program data when the host may not even contain such data would not be known. Claims 11 and 13 have a similar issue. Dependent claims 10, 12, 14, and 15 inherit this issue.

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites "a storage element for storing data output from said host machine" in line 4 of the claim, indicating that the program data (such as the reproduction program data and execution program data) are output from the host (thus indicating that these programs are already stored on the host) to the storage element of the portable memory device. However, other claim limitations (e.g., "when the host machine does not store the reproduction program data, the execution program data and the driver program data, the install program data automatically installs the reproduction program data, the execution program data and the driver program data on the host

machine in response to connecting the portable memory device to the host machine" on lines 17-21 of claim 9) indicate that the reproduction program data and execution program data are not stored on the host, which contradicts the previous limitation of "a storage element for storing data output from said host machine". If any of these claim limitations are optional, this must be more clearly and consistently expressed in the claim to resolve this contradiction. As claimed currently, it is unclear to one of ordinary skill in the art what is happening when the host machine does not store reproduction program data and execution program data. How is the host machine outputting the reproduction program data and execution program data if the data may not even be stored on the host? Appropriate correction is required. Claims 11 and 13 have a similar issue. Dependent claims 10, 12, 14, and 15 inherit this issue.

#### **ARGUMENTS CONCERNING NON-PRIOR ART REJECTIONS/OBJECTIONS**

##### **Specification Objections**

Applicant's arguments/amendments with respect to the specification have been considered, but more objections to the specification remain as noted *supra*.

##### **Claim Objections**

Applicant's arguments/amendments with respect to the claim objections of claims 9, 11, and 13 have been considered and have overcome the Examiner's prior objections and thus are withdrawn.

**Rejections - USC 112**

Applicant's arguments/amendments with respect to claims 9, 11, and 13 have been considered but are not persuasive, as new issues under USC 112 have been raised. How the "data output from said host machine" (including data such as the reproduction program data and execution program data) is transferred from the host machine to the storage element (and vice versa) is not adequately enabled by the specification and is also unclear to one of ordinary skill in the art as described in the rejection *supra*.

**CLOSING COMMENTS**

**Conclusion**

**STATUS OF CLAIMS IN THE APPLICATION**

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. ' 707.07(i)**:

**CLAIMS REJECTED IN THE APPLICATION**

Per the instant office action, claims 9-15 have received a first action on the merits and are subject of a first action non-final.

**DIRECTION OF FUTURE CORRESPONDENCES**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272-4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino

/M.G./

Patent Examiner  
Art Unit 2185

July 18, 2011

**/Stephen Elmore/  
Primary Examiner**  
Art Unit 2188